

Notice of Allowability**Application No.**

09/720,598

Examiner

Robert Shiao

Applicant(s)

BOCQUENET ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to responses filed on 07/19, 2004.
2. ☒ The allowed claim(s) is/are 22-24, 28-29, and 31-36, now are 1-11.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

DETAILED ACTION

1. This application claims benefit of the foreign application:
France 98/08258 with a filing date 06/25, 1998.
2. Amendment of claim 23-24, 34-36, cancellation of claims 1-21, 25-27, 30 in
Paper No. 0704, dated July 19, 2004, is acknowledged. Claims 22-24, 28-29, and 31-36
are pending in the application.

Responses to Amendment and Arguments

3. Since the limitation of the starting materials aminonitrile has been incorporated
into claims 34-36, therefore, the rejection of claims 34-36 under 35 U.S.C. 112, first
paragraph, has been overcome in Paper No. 0704, dated July 19, 2004. Applicant's
arguments regarding the rejection of claim 36 under 35 U.S.C. 112, second paragraph,
filed on July 19, 2004, have been fully considered and they are persuasive. Therefore,
the rejection of claim 36 under 35 U.S.C. 112, second paragraph, is withdrawn herein.
4. Applicant's arguments regarding the rejection of claims 22-24, 28-29, and 31-36
under 35 U.S.C. 103(a), filed on July 19, 2004, have been fully considered and they are
persuasive. Since applicants stated that the instant invention and Cotting et al. US
6,262,259 were owned by or subjected to an obligation of assignment to the same
person when the present invention was made. Therefore, Cotting et al. '259 is no
longer a prior art over the instant invention, and the rejection of claims 22-24, 28-29, and
31-36 under 35 U.S.C. 103(a) is obviated herein.

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5. Applicant's arguments regarding the rejection of claims 22-24,28-29, and 31-36 under obviousness-type double patenting filed on July 19, 2004, have been fully considered and they are persuasive. Applicant states that results as shown in Comparative Example 1 on the page 8 of the specification, a vaporized mixture of the reactants is charged to the hydrolysis reactor, is inferior to the instant processes. Since unexpected results of the instant invention could not have been predicted from Cotting et al. US 6,262,259, using a process of a vaporized mixture of the reactants being charged to the hydrolysis reactor, therefore, the rejection of claims 22-24,28-29, and 31-36 under obviousness-type double patenting is withdrawn herein.

EXAMINER'S AMENDMENT

6. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with George F. Lesmes on September 17, 2004. The application has been amended as follows:

In claim 22, line 2, after "between water vapor and", delete "an aminonitrile", and insert

--a linear or branched aliphatic aminonitrile having 3 to 12 carbon atoms--

Reasons for Allowance

7. The following is an examiner's statement of reasons for allowance:

Claims 22-24,28-29, and 31-36 are neither anticipated nor rendered obvious over the art of record, and therefore are allowable. This invention relates to method for evaporating aminonitrile. The closest prior art of record is Cotting et al. US 6,262,259, discloses method for preparing lactam. The difference between instant claims and Cotting et al. is that instant claims using the reactant water in the vaporization phase is not disclosed in the process of Cotting et al. Suggestion for modification of prior art to obtain the instant processes has not been found. Claims 22-24,28-29, and 31-36 are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusions

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-

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872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

for R. Desai
Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626

9/20/04

R. S.
Robert Shiao, Ph.D.
Patent Examiner
Art Unit 1626

September 20, 2004